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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 22.1410 (SHL.0114US)	
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		First Named Inventor Peter A. Goode et al.	
		Art Unit 3671	Examiner Thomas A. Beach
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a notice of appeal. The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the <input type="checkbox"/> applicant/inventor. <input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96) <input checked="" type="checkbox"/> attorney or agent of record. Registration number 40,779 <input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____		 Signature Fred G. Pruner, Jr. Typed or printed name (713) 468-8880 Telephone number October 15, 2009 Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.			

☒ *Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Applicants:	Peter A. Goode et al.	§	Art Unit:	3671
		§		
Serial No.:	09/920,895	§	Conf. No.:	9846
		§		
Filed:	August 2, 2001	§	Examiner:	Thomas A. Beach
		§		
Title:	WELL HAVING A SELF- CONTAINED INTERVENTION SYSTEM	§	Docket No.	22.1410 (SHL0114US)
		§		

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Applicant hereby requests pre-appeal review of the § 103 rejections of claims 10-12, 25-29 and 44-51. All of these rejections are based at least in part on the combination of U.S. Patent No. 6,302,199 (Hawkins) and U.S. Patent No. 6,182,765 (Kilgore).

As a brief summary of the prosecution history of this application, the Examiner previously rejected independent claims 10 and 44 under 35 U.S.C. § 102(b) as being anticipated by Kilgore, and these rejections were the subject of an appeal in which the rejections were reversed by the Board of Patent Appeals and Interferences (hereinafter called the "Board"). One issue decided on by the Board in this appeal was whether Kilgore explicitly or inherently discloses halting the flow of fluid in a well in connection with the deployment of a tool. In particular, the Board found the following:

We do not agree with the Examiner's analysis (Ans. 3-5) and find that Kilgore does not implicitly or inherently disclose halting the flow of fluid in the well 100 in connection with the deployment of the tool string 315. We conclude that Kilgore does not disclose halting the flow of fluid in a well, deploying a tool while the fluid is halted; allowing the tool to free fall in the well while the fluid is halted; and resuming the flow to retrieve the tool as called for in claims 10 and 44, and claims 11, 12, 25, 26, 28, 29, 45-48, 50 and 51, respectively.

Date of Deposit: October 15, 2009

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Janice Munoz

Decision on Appeal, ll. 23-26, p. 6 and ll. 1-4, p. 7. Thus, the Board expressly found that Kilgore fails to explicitly or inherently disclose halting the flow of fluid in connection with the deployment of a tool.

After the Decision on Appeal, the Examiner reopened prosecution with the latest Office Action mailed on July 15, 2009 (herein called the "Office Action"), which rejects independent claims 10 and 44 as being unpatentable under 35 U.S.C. § 103(a) over Hawkins in view of Kilgore. In these rejections, the Examiner concedes that Hawkins fails to disclose resuming a flow to retrieve a tool, which is explicitly recited in independent claims 10 and 44 and relies on Kilgore for this teaching. Office Action, p. 2.

However, it is illogical to conclude that Kilgore discloses *resuming* a previously halted flow to retrieve a tool, given the Board's explicit finding that Kilgore fails to explicitly or inherently disclose halting the flow in the deployment of the tool (*emphasis added*). In other words, Kilgore fails to disclose shutting off or resuming a flow in connection with deploying or retrieving a tool. The Examiner resolves this discrepancy by stating, "thus clearly it flows from the reference (Kilgore) that freefall requires the halting and pressurized fluid flow in order for the tool deployment to freefall." Office Action, p. 5. This position taken by the Examiner, however, directly contradicts the findings of the Board. In this manner, the Board has already considered and rejected the Examiner's argument that Kilgore purportedly discloses halting the flow of a fluid for purposes of deploying a tool due to Kilgore's disclosure that the tool "free falls" during its deployment. *See, for example*, lines 18-23 on page 6 of the Decision on Appeal, which is reproduced below:

Further, we find that since the operation of the servicing and completion system 240 includes the tool string 315, the tool string 315 may be operated while the well is still in operation with fluid flowing in the well 100. Therefore, we find that when the tool string 315 is allowed to free-fall (Fact 4), fluid may be flowing the well 100. We do not agree with the Examiner's analysis (Ans. 3-5)....

37 C.F.R. § 1.198 states that when a decision by the Board has become final, prosecution may only be opened for matters that have not already been adjudicated:

When a decision by the Board of Patent Appeals and Interferences on appeal has become final for judicial review, prosecution of the proceeding before the primary examiner will not be reopened or reconsidered by the primary examiner except under the provisions of § 1.115 or § 41.50 of this title without the written authority of the Director, *and then only*

*for the consideration of matters not already adjudicated, sufficient cause being shown
(emphasis added).*

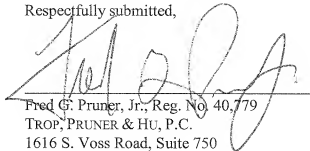
The Examiner had the opportunity to request the Board to reconsider its decision. M.P.E.P. § 1214.04. However, the Decision on Appeal is now final, and as such, the Examiner has no discretion of whether or not to ignore the findings made by the Board. Thus, the Board has found that Kilgore fails to explicitly or inherently disclose halting the flow of fluid during the deployment of a tool in a well, and as such, it follows, Kilgore fails to disclose resuming a halted flow to retrieve the tool.

The § 103 rejections of independent claims 10 and 44 are based on Kilgore's purported disclosure of resuming a flow to retrieve a tool. Resuming the flow, however, cannot occur if the flow is not halted. The § 103 rejections fail to set forth any plausible reason to explain why the skilled artisan in possession of Hawkins and Kilgore would have otherwise derived resuming a halted flow to retrieve a tool. Thus, the § 103 rejections of independent claims 10 and 44 are deficient. Dependent claims 11, 12, 25-29 and 45-51 overcome the § 103 rejections for at least the same reasons as claims 10 and 44.

Given the Decision on Appeal and the failure by the Examiner to present *prima facie* § 103 rejections that are consistent with the Board's findings, Applicant respectfully requests withdrawal of the § 103 rejections and allowance of the application.

The Commissioner is authorized to charge any additional fees, including extension of time fees, and/or credit any overpayment to Deposit Account No. 20-1504 (SHL.0114US).

Respectfully submitted,



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Date: October 15, 2009